REMARKS

The claims have been amended to more clearly define the invention as disclosed in the written description. In particular, claim 12 has been made an independent claim and now includes all of the steps performed by the programmable device under control of the computer program product carried by the computer-readable medium. In addition, claim 2 has been cancelled, while claim 1 has been amended to include the limitations of cancelled claim 2. Furthermore, claims 1 and 11 have been amended for clarity.

Applicants believe that the above changes answer the Examiner's 37 C.F.R. 1.75(c) objection to claim 12, and respectfully request withdrawal thereof.

Applicants further believe that the above changes answer the Examiner's 35 U.S.C. 101 rejection of claims 1, 3, 8 and 10 as being directed to non-statutory subject matter, and respectfully request withdrawal thereof.

The Examiner has rejected claims 1-3 and 7-12 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,630,963 to Billmaier. The Examiner has further rejected claims 1-4 and 6-12 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 7,162,728 to Bahn. In addition, the Examiner has rejected claims 1, 3 and 8-12 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,440,351 to Ichino. Moreover, the Examiner has rejected claims 4 and 6 under 35 U.S.C. 1039a) as being unpatentable over Billmaier in view of Bahn. Furthermore, the Examiner has rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Billmaier

in view of Bahn, and further in view of U.S. Patent Application Publication No. 2004/0068553 to Kotz et al. The Examiner has additionally rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Bahn in view of Kotz et al. Finally, the Examiner has rejected claim 2 and 4-7 under 35 U.S.C. 103(a) as being unpatentable over Ichino in view of U.S. Patent 6,195,707 to Minh.

The Billmaier patent discloses synchronizing a video program from a television broadcast with a secondary audio program, in which a user is able to select and listen to a second audio program from a separate source while watching the video portion of a television broadcast.

As noted in MPEP § 2131, it is well-founded that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 includes the limitation "identifying means for identifying that historically the user concurrently uses a second content of a second type when using said first content of the first type, said second content being unrelated with the first content". The Examiner has indicated that Billmaier discloses this limitation "(see disclosure that a user selects a secondary audio program to

replace the primary audio program associated with a television transmission, col. 9, lines 1-10 et seq.)."

Applicants submit that the Examiner is mistaken. In particular, Billmaier teaches "a program selector component 906, which allows a user to select a particular secondary audio program 510 to replace the primary audio program 506 associated with the television transmission" (col. 9, lines 1-5). At best, the program selector component acts as means for enabling the execution of the current desire of the user to watch a particular television program while listening to a second content of a second type. However, there is nothing in Billmaier that would enable the system therein to identify how, historically a user behaves when a particular first content is used. In the subject invention, on the other hand, the identifying means may include a camera monitor for recording the actions of the user. This means would then be able to identify that when the user watches a particular television program, the user also listens to a second content of a second type. As such, without the user actually switching to the second content of the second type, the system already has identified that when the user uses a first content of a first type, the user also concurrently uses a second content of a second type.

The Bahn patent discloses a system and method to provide audio enhancements and preferences for interactive television, in which a user is able to, for example, listen to jazz style music while viewing content on a shopping channel accessed over interactive television.

Claim 1 includes the limitation "identifying means for identifying that historically the user concurrently uses a second content of a second type when using said first content of the first type, said second content being unrelated with the first content". The Examiner has indicated that Bahn discloses this limitation "(see disclosure that the system allows a user to customize audio content on interactive television, col. 2, lines 8-10 et seq.)."

Applicants submit that, as with Billmaier, Bahn merely discloses a user interface where the user can first choose the video program to be watched, and then choose an audio program to be listened to while viewing the chosen video program. However, there is no identifying means in Bahn that knows a priori (historically) that the user while using a first content of a first type, also concurrently uses a second content of a second type.

The Ichino patent discloses a television with user-selectable radio sound. However, again, as with Billmaier and Bahn, Ichino merely enables the user to first choose the video program to be watched, and then choose an audio program to be listened to while viewing the chosen video program. However, there is no identifying means in Ichino that knows a priori (historically) that the user while using a first content of a first type, also concurrently uses a second content of a second type.

The Kotz et al. publication discloses a method and apparatus for personalized content presentation, in which the system dynamically tailors selection of rich content for recommendation to a user wherein the recommendation process

determines a recommendation in accordance with past user selections.

However, Applicants submit that Kotz et al. does not supply that which is missing from either Billmaier or Bahn, i.e., "identifying means for identifying that, historically, the user concurrently uses a second content of a second type".

The Minh patent discloses an apparatus for implementing universal resource locator (URL) aliases in a web browser and method therefor, in which, instead of using a particular URL to access a web page, a user is able to define a URL alias which then enables the user to link to the appropriate URL. These URL aliases may then be stored in an alias file.

However, Applicants submit that while Minh may discloses associating a URL alias with a URL, there is no disclosure or suggestion of meta-data comprising information pertaining to said associated first and second content. Furthermore, Applicants submit that Minh does not supply that which is missing from Ichino, i.e., "identifying means for identifying that historically the user concurrently uses a second content of a second type".

In view of the above, Applicants believe that the subject invention, as claimed, is neither anticipated nor rendered obvious by the prior art, either individually or collectively, and as such, is patentable thereover.

Applicants believe that this application, containing claims 1-12, is now in condition for allowance and such action is respectfully requested.

Respectfully submitted,

by__/Edward W. Goodman/_____
Edward W. Goodman, Reg. 28,613
Attorney
Tel.: 914-333-9611